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287657

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/287.657 08/09/94 HOOD

L 37231.P006X

SHAY, D EXAMINER

33M1/0907

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD 7TH FLOOR
LOS ANGELES CA 90025

ART UNIT PAPER NUMBER

3309

DATE MAILED: 09/07/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-24 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-24 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Best Available Copy

Claims 1-14, and 19-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is incomplete as there is no positive structural connection recited between the speculum and the rest of device and because a simple power source absent a high frequency generator is incapable of forming a thermokeratoplastic probe system. In claim 10 exactly what constitutes a "step" is unclear. In claim 19 exactly what constitutes a "fuse" is unclear, since the term "opens said fuse" implies the fuse could be a switch. In claim 21 "the other electrode" lacks positive antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 11, and 13 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Petersen.

Claims 10 and 12 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Beale.

Claims 16-18 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Poler.

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Claim 19 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Newton ('030) or Norman et al.

Claims 19 and 20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Rexroth et al.

Claims 20, 21, and 24 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Doss.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 14 and 15 are rejected under 35 U.S.C. § 103 as being unpatentable over Petersen in combination with Poler. Petersen teaches a device as claimed outer electrode and a fluid passage. Polar teaches employing an outer electrode and a fluid passage. It would have been obvious to the artisan of ordinary skill to include an outer electrode and a fluid passage in the device of Petersen, since this would enable bipolar surgery and flushing,

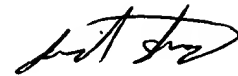
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thus producing a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330

D. Shay/pw
July 25, 1995
August 19, 1995
Fax: 703-305-3590